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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,263	07/27/2001	Jing Wu	002010-593	7971

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EXAMINER

KIFLE, BRUCK

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 02/12/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/915,263

Applicant(s)  
Wu et al.

Examiner  
Bruck Kifle, Ph.D.

Art Unit  
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 18, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 99-112 and 118-130 is/are pending in the application.
- 4a) Of the above, claim(s) 99-112 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 118-130 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

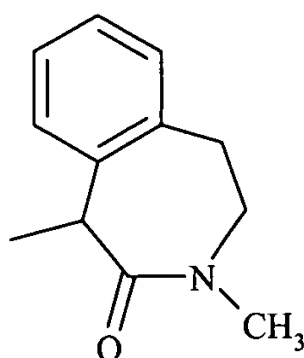
- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5, 16, 1 ? 6) ☐ Other:

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Applicant's amendments and remarks filed 12/10/02 have been received and reviewed.

Claims 99-112 and 118-130 are now pending in this application.

Applicants are advised that only the elected subject matter is under consideration. That is, compounds and pharmaceutical compositions, wherein W, together with  $-C(H)_pC(=X)$ , and Q form the ring system



is under consideration.

Claims 99-112 along with subject matter not embraced by this ring system of the remaining claims are withdrawn from consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected subject matter. Election was made without traverse in Paper No. 11.

Applicants are advised that this application still contains non-elected subject matter in the claims. Note, the court in *In re Herrick et al* and *In re Joyce* (both at 115 USPQ 412) held that an election of species requirement was, in fact, a restriction requirement.

### ***Improper Markush Rejection***

Claims 118-130 are again rejected as being drawn to an improper Markush group, that is, the claims lack unity of invention. The basis of this rejection is the same as given in the previous office action and is incorporated herein fully by reference. Applicants argue that the Examiner

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did not consider the compound as a whole. However, the compounds were in fact considered as whole and determined that their inclusion in a common group is repugnant to principles of scientific classification. In re Harnish restricted the applicant to one core, and indicated in footnote 7, thereof, that a restriction and rejection based on a reference for one ring not being a reference for another was authorized (206 USPQ 300 at 305 and 306). Footnote 7 of Harnish says “having recognized the possibility of rejecting a Markush group on the basis of independent and distinct inventions” in that a reference for one would not be a reference for the other.

Limiting the claims to compounds wherein W, together with  $-C(H)_pC(=X)$ , and Q form the elected ring system (the benzoazepinone ring) would overcome this rejection.

### *Provisos*

There are provisos in the claims that exclude compounds embraced by the claims. If these provisos are present to avoid prior art, applicants are urgently requested to point out these references to the examiner because of their importance in the examination of the claims.

Applicants did not respond to this query.

Applicants comment regarding overlapping subject matter in WO 99/67221; WO 98/28268 and WO 2001/034571 is sought. Applicants are required to maintain a clear line of demarcation between the applications. See MPEP § 822. Applicants have not indicated what the differences are.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is (703) 305-4484.

The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

February 7, 2003

  
**Bruck Kifle**  
**Primary Examiner**  
**Art Unit 1624**